

REMARKS

The present Amendment is filed in response to the Official Action mailed March 7, 2007. The three-month shortened statutory period for filing a response having expired on June 7, 2007, Applicants submit herewith a three-month extension petition to reset the deadline for responding to and including September 7, 2007. In light of the enclosed amendments and remarks, reconsideration of the Examiner's rejections and notice of allowance of all pending claims is respectfully requested.

Claims:

Previously withdrawn claims 1 to 50 and 61 to 67 are hereby canceled, leaving claims 51-60 pending in this application.

Priority:

In the Official Action, the Examiner stated that the present application was not entitled to claim priority to its parent application because the two applications were not co-pending. Applicants respectfully disagree, as follows.

When an abandoned application is revived by the Commissioner, it becomes reinstated as a pending application and *the preceding period of abandonment has no effect*. Thus, when the parent application was revived, it was pending continuously from the time it was filed through to the date it was revived. The present application was thus properly filed during the time the parent application was pending.

The Examiner asserts that a patent application is not pending between the time it has been abandoned and the date in which it is revived. If this were true, a continuation application that claims priority to an abandoned parent application could never be filed until the date at which the

decision was made to revive the parent application.

The Applicants are aware of no such requirement in the statutes or MPEP that requires an Applicant to wait until the day when the parent application is revived in order to file the continuation application. Instead, the statutes explicitly state that: "In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuation application." (See Petitions Practice Within the USPTO on Patent Matters at:

<http://www.uspto.gov/web/offices/pac/dapp/petitionspractice.html>)

(copy attached).

In addition, MPEP 711.03(c) explicitly states that a Petition to Revive must be accompanied by "the required reply", and that "the required reply" may be either: (i) an argument or amendment, or (ii) the filing of a continuation application. As such, it is clearly permissible to file a continuation application at the time of filing the Petition to Revive.

Any continuation application filed concurrently with a Petition to Revive would have to be filed prior to the decision made to grant the Petition to Revive (i.e.: prior to the point in time at which it the parent application is actually revived).

Lastly, on page 5 of 15 of the referenced document, with respect to remedy to correct 37 C.F.R. 1.53 filing errors, the USPTO has stated that Applicants should "Remember, copendency cannot be waived as it is a **statutory** requirement. Therefore, applicant must petition to revive the parent application under 37 CFR 1.137 to obtain copendency if the parent application became abandoned prior to filing of the continuing application." This is the exact remedy utilized by Applicants herein, and should be permitted by the USPTO.

In view of the forgoing, reconsideration is respectfully requested.

Section 112 Rejections:

The Examiner found claims 51, 56 and 57 to be unclear. These claims have now been amended as described below. It is believed these amendments overcome the present § 112 rejections.

Note: In claim 56, the phrase "diffusively or non-diffusively" has been removed for clarity.

Note: In claim 56, the location of the sample porous member is now described as being "in contact with" the porous member. This is seen in Fig. 4 where filters 28 is positioned in contact with porous test strip 12.

Section 103 Rejections:

(a) The Rejections:

The Examiner rejected independent claim 51 over Fitzpatrick in view of Robinson.

(b) The Presently Claimed Invention:

Claim 51 sets forth a porous member having a "test zone" and a "reference zone".

Claim 51 has been amended to clearly set forth: a first reagent forming a detectable response in the test zone, and a second reaction product forming a detectable response in the reference zone. Importantly, however, presently amended claim 51 sets forth [emphasis added]:

b) ..... the detectable response in the test zone being *inversely* proportional to the analyte concentration;

c) ..... [the] detectable response in the reference zone being *directly* proportional to the analyte concentration;

wherein the detectable response in the test zone plus the detectable response in the reaction zone equal a *total detectable response that is substantially constant for the pre-determined range of analyte concentration.*

As set forth at page 15, line 17 to page 16 line 3 of the specification, the first test zone produces a signal that is inversely proportional to analyte concentration whereas the second test zone produces a signal that is directly proportional to analyte concentration.

The benefit of this system is that the total signal is substantially constant independent of the analyte concentration.

As a result, the total signal serves as a reference mechanism for both the assay procedure and the reagent quality. Thus, if the total signal is below a specified range, the user can be notified of an error. In addition, the specific reason for the incorrect assay procedure can be identified. (See page 25, lines 4 to 12 of the specification). This provides a reliable assay result and quality reference since the sum must stay within a specified range, otherwise an assay failure is indicated. (See page 47, lines 24 to 26 of the specification).

Neither the Fitzpatrick nor Robinson disclose the presently claimed feature set forth in presently amended claim 51.

In view of the present amendment and remarks, the allowance of claims 51, and all claims depending therefrom, is respectfully requested. It is also believed that such dependent claims include patentable subject matter beyond that found exclusively in claim 51.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: September 7, 2007

Respectfully submitted,

By



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## Petitions Practice Within the USPTO on Patent Matters

This page provides some of the basic principles of **petitions practice**. As with all aspects of patent prosecution, there are laws and regulations that must be followed by employees of the USPTO in the area of petitions. The USPTO recommends that inventors and applicants unfamiliar with the patent laws, rules, and USPTO procedures, consult a registered patent attorney or agent to conduct the prosecution of their patent applications. Although the USPTO may not recommend a particular patent attorney or agent, you can select from a list of patent attorneys and agents registered to practice before the USPTO.

The links provided in this text will take you to a page on the USPTO website where you can either view or download the cited law, rule, or Manual of Patent Examining Procedure (MPEP) section. At this time it is not possible to directly link to a specific section for all citations of Laws (35 U.S.C.) or Rules (37 C.F.R.). Since all such links take you to the same location, just click on any similar linked citation. After you view the citation in which you are interested, use your browser's [BACK] button to return to this page.

Links to printable forms (where provided) should take you directly to the form if you have a current version of Adobe Acrobat Reader properly loaded. >> view all USPTO forms

For those patent matters that are not subject to an appeal to the Board of Patent Appeals and Interferences and the federal courts, supervisory and administrative review is conducted, in part, by the rendering of decisions on petitions. The Director of the USPTO (formerly the Commissioner) has delegated to appropriate USPTO officials the authority to decide certain petitions. The various delegations are set forth in Chapter 1000 of the MPEP. The more common types of petitions handled in the Office of Petitions are identified below and the requirements which must be met for the granting of a petition are discussed. Where appropriate, links to other information are provided.

## REQUIREMENTS OF A PETITION

In general each petition has five (5) requirements. These requirements are as follows:

1. The petition must be in writing, 37 CFR 1.2.

All business with the USPTO is transacted in writing. The petition should be directed to the USPTO official delegated the authority to decide that petition. See MPEP Chapter 1000. Since different matters may be considered by different branches or sections of the USPTO, each distinct subject, inquiry or request

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Commissioner  
for Patent  
Examination  
Policy **PHONES**

International  
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Patent  
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Office of Patent  
Legal  
Administration

should be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. 37 CFR 1.4(c).

2. The petition must contain a **statement of facts** involved, the **point(s)** to be reviewed and the **action requested**, 37 CFR 1.181(b).

The care and completeness with which petitions are drafted can clearly influence the decision rendered. 37 CFR 1.181(b) sets forth the general requirements for the content of a petition. The petition must contain a statement of the facts involved, the point(s) to be reviewed and the action or relief requested. The petition submitted should be as complete as possible and any evidence necessary should be submitted. Any error(s) in a requirement or action on the part of the USPTO should be clearly set forth with the reasons why such requirement or action is considered improper.

3. The petition must be **accompanied by a fee**, if required, in order to avoid the petition being summarily dismissed, 37 CFR 1.181(d).

To avoid a petition being summarily dismissed for lack of insufficient fee, petitioner should make certain that the correct petition fee is submitted along with the petition. See the updated fee sheet for guidance.

4. The petition must be **timely filed**, as required in 37 CFR 1.181(f), or as required in a specific statute or regulation.

Generally a petition not filed within two (2) months from the action complained of may be dismissed as untimely. Further, the mere filing of a petition will not stay the period for replying to an examiner's action that may be running against an application or act as a stay of other proceedings. 37 CFR 1.181(f).

5. The petition must **comply with any specific requirements** as provided by statute, regulation or USPTO policy.

Care should be taken to review the applicable statute, regulation or USPTO policy to determine if there are other requirements that need to be met in submitting the petition.

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### **Specific Types of Petitions Treated in the Office of Petitions**

**Inventor Unavailable • Correct Filing Date • Abandonment or Lapse • Maintenance Fee**

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#### **A. Petitions to Permit Filing a Patent Application When An Inventor Refuses or Cannot Be Reached to sign the Oath or Declaration** See MPEP 409.03

Where a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, a petition under 37 CFR 1.47(a) may be filed to permit acceptance of an application filed by the other inventor(s) on his or her behalf and that of the non-signing inventor. The submission must set forth the diligent efforts made to contact the non-signing inventor, the required fee

and the **last known address** of the non-signing inventor.

Similarly, whenever all of the inventors or the sole inventor refuse(s) to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventors have assigned or agreed in writing to assign the invention or who otherwise shows **sufficient proprietary interest** in the matter justifying such action may file an application for patent on behalf of the non-signing inventor(s). A petition to permit filing under 37 CFR 1.47(b) must be submitted with the **oath or declaration** executed by the Rule 47 applicant on behalf of the non-signing inventor(s).

Either of the above petitions must include:

1. **Proof** that the **non-signing inventors** were presented with the application papers and **refused to sign** the oath or declaration or that the non-signing inventor(s) **could not be found or reached after diligent effort**;
2. **The required fee**; and
3. **The last known address** of the non-signing inventor(s).

Additionally, when filing under 37 CFR 1.47(b) petitioner must provide **proof of proprietary interest** and state that the filing of the application for patent is **necessary to preserve the rights of the parties or to prevent irreparable damage**. Proof of proprietary interest may be provided with a copy of an **assignment, a written agreement to assign or a memorandum of law** establishing that a court of competent jurisdiction would award title of the invention to the Rule 47 applicant.

In a **continuation or divisional** application, a copy of an **oath or declaration** from a prior application may be filed. If a petition under 37 CFR 1.47 was granted in the **prior application** and the non-signing inventor(s) did not later join in the application, a **copy of the decision granting status** under 37 CFR 1.47 in the prior application must also be filed.

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**B. Petitions to Obtain or Correct a Filing Date**      See MPEP 600

37 CFR 1.53 provides procedures for filing patent applications. All applications filed under 37 CFR 1.53(b) require a **specification**, including at least one **claim, drawings, if necessary** to understand the claimed subject matter, an oath or declaration, and the required **filing fee**. Before an application is examined to determine patentability, the application, by law, must be complete so as to receive an official filing date. If the application is complete, the applicant will receive a filing date receipt. Failure to file a complete application will result in the USPTO forwarding a communication to the applicant noting that errors/problems exist in the application filing which require correction.

When filing an application for patent, applicant is encouraged to submit a **self addressed postcard** with the application papers. See MPEP 503. The postcard should indicate **what is being submitted** to the USPTO. For example only, the postcard should state "transmitted herewith is an application for patent for John J. Johns, including 5 pages of specification, 6 claims, 4 sheets of drawings having 9 figures therein, a signed declaration, and a check in the



amount of \$\_\_\_\_\_ for the statutory filing fee." (Be sure to check the latest fee sheet for the correct amount of fees to submit.) The postcard will be date stamped by the USPTO mailroom and will serve as proof of what was submitted by applicant. It is important that the postcard **itemize all of the components** of an application. If the postcard does not itemize each of the components of the application, **it will not serve as evidence that any component which was not itemized was received by the USPTO.**

Once the official filing receipt for the patent application is received, a **review of the filing receipt** should be made to ascertain whether the filing date and other application data are correct. If the information there on is **incorrect**, applicant should **promptly contact the USPTO**. Keep in mind that the **filing date receipt is not an indication that a patent will issue**. It merely signifies that a complete application has been filed and that the application will be forwarded to a patent examiner for examination purposes.

To provide applicants with a more detailed recitation of the **typical types of errors** committed in filing applications and how to rectify such errors, the following topics and discussion relating thereto is provided.

### 1. Common Errors When Filing Applications

- The application is not accompanied by a **return postcard listing the parts** of the application in sufficient detail to serve as evidence of the exact papers which were filed.
- The application is not accompanied by the **correct filing fee** or the appropriate declaration for application (see for example, <http://www.uspto.gov/web/forms/sb0001.pdf>).
- The applicant wants the **date the application was mailed** to the USPTO as the application filing date, but fails to use the **"Express Mail Post Office to Addressee"** service of the **U.S. Postal Service** to deliver the application. **Only the "Express Mail Post Office to Addressee" service of the US Postal Service can be used to obtain the date of mailing as an application filing date.**
- The applicant fails to retain a **complete copy** of the application.
- The **nonprovisional** application is filed without a **claim**.
- The copy of the application forwarded to the USPTO is **missing one or more pages of the specification or drawings**.
- The application is filed without a **correspondence address**.

### 2. Things to Remember

- The patent application process is **complex**. The USPTO cannot assist in the preparation of application papers. If you are ready to apply for a patent, we strongly advise you to contact a registered patent attorney or agent to assist you.
- There are **several types of patent application**, for example, utility, design, provisional, nonprovisional, each of which requires different filing fee and has a different legal effect.

- The application must be accompanied by a request not to publish the application, if pre-patent grant publication is not desired.

### **3. Remedy to Correct Errors**

The usual remedy to correct a 37 CFR 1.53 filing error is to file a petition directed to the Office of Petitions explaining the delay in submitting the omitted item. Any missing items should accompany the petition and should be accompanied by the fee required by 37 CFR 1.17(h).

Remember, copendency cannot be waived as it is a statutory requirement. Therefore, applicant must petition to revive the parent application under 37 CFR 1.137 to obtain copendency if the parent application became abandoned prior to filing of the continuing application.

### **4a. Express Mail Errors**

Typical Errors committed by applicants who use the provisions of 37 CFR 1.10 ("Express Mail" procedures) are described below.

- Problems arise when correspondence is deposited in an Express Mail drop box late in the day after the last pick-up has occurred. The "Date-In" on the label is the date the Post Office receives the correspondence. Applicants should deposit the correspondence directly with an employee of the US Postal Service at the Post Office window when possible and get a legible copy of the "Express Mail" mailing label with the "Date-In" clearly marked. Applicants should then check the "Date-In" on the receipt. The "Date-In" must be entered by the Post Office, not applicant (See MPEP 513);
- Applicants file separate papers or different applications in the same mailing envelope which do not each have the Express Mail number thereon;
- The proper postage has not been provided.
- The Express Mail label is not properly addressed.

### **4b. Remedy to Correct Errors**

**Express Mail correspondence received in the USPTO, but given a date other than "date-in" on the receipt.**

In accordance with 37 CFR 1.10(c), one may file a petition to have an earlier filing date accorded, provided that:

- (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

**Express Mail correspondence given incorrect date or no date by the USPS.**

In accordance with 37 CFR 1.10(d), one may file a petition to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

**Express Mail correspondence not received in the USPTO.**

In accordance with 37 CFR 1.10(e), one may file a petition to have such correspondence considered as having been filed in the USPTO on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label **was placed** on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;"

(3) The petition includes a **copy** of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the **number** of the "Express Mail" mailing label thereon, a copy of any returned **postcard receipt**, a copy of the "Express Mail" mailing label showing the **"date-in,"** a copy of any other **official notation by the USPS** relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph B(3), above, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a **statement** which establishes, to the satisfaction of the Commissioner, the **original deposit** of the correspondence, and that the copies of the **correspondence**, the copy of the "Express Mail" mailing label, the copy of any returned **postcard receipt**, and any **official notation entered by the USPS** are **true copies** of the originally mailed correspondence and original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

**5a. Missing Drawing(s)/Figure(s) or Omitted Specification Page(s)**

(1) A **drawing** is required for a filing date where it is necessary for the **understanding of the subject matter** sought to be patented ( 35 U.S.C. 111 and 113, 1st sentence), or if described in the **specification** (MPEP, 506, 601.01 and 608.02);

(2) Check the application before filing to ensure that any **drawing** referred to in the **specification** is present;

(3) Check the drawings to ensure that each **figure** is properly labeled;

(4) **Number each page** of the **specification** in consecutive order and review the application for **completeness** before filing;

(5) A postcard receipt should contain a **specific itemization** of all the items being submitted (MPEP 503). Therefore, the post card receipt should specifically itemize the number of pages of the specification, the number of pages of the declaration and the number of sheets of drawings (including the number of figures contained thereon) being submitted. (Note: hundreds of postcard receipts each year are never returned to counsel because correct postage or return address is lacking);

(6) The best evidence of what the Office received is a properly itemized postcard receipt stamped with the mail room date.

#### **5b. Remedy to Correct Errors**

If an application is filed without all the pages of the specification or without all of the figures of the drawings, the Office will still accord a **filing date** to any application that contains something that can be construed as a **written description**, any **necessary drawing**, and, in a nonprovisional application, **at least one claim**. The Office will mail a notice to applicant indicating that the application has been accorded a filing date, but is missing pages of the specification or figures of drawings. The mailing of the notice will permit applicant to either: (1) promptly establish prior receipt in the USPTO the pages at issue (generally by way of a date-stamped postcard receipt); or (2) promptly submit the omitted page(s) and accept the date of submission as the application filing date. See MPEP 601.01 (d).

An applicant asserting that the page(s) was in fact deposited in the Office with the application papers must promptly file a petition under 37 CFR 1.53(e) (and the petition fee under 37 CFR 1.17(h) which will be refunded if it is determined that the page(s) was in fact received by the USPTO) with evidence of such deposit.

Applicants desiring to submit the omitted page(s) and accept the date of submission as the application filing date must promptly submit the omitted pages or drawings and include an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such page(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date.

Failure to promptly (within an extendable **two month** period) file a petition under 37 CFR 1.53(e) or 1.182 in response to such notice will result in the Office treating the application as including only those papers originally deposited. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and to cancel any incomplete sentences.

Petitions to obtain or correct a filing date should be directed to the attention of the **Office of Petitions** and must include the **petition fee** or an authorization to charge the petition fee to a deposit account. If

the petition alleges that no defect exists, a request for refund of the petition fee maybe included in the petition.

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**C. Petitions Relating to Abandoned Applications or Lapsed Patents** See MPEP 711.03 (c)

**Revival**

**37 CFR 1.137** covers petitions to revive applications abandoned for failure to prosecute, or failure to pay the required issue fee and petitions to revive a lapsed patent for failure to pay any balance of the issue fee due. There are two kinds of petitions to revive identified in this regulation. 37 CFR 1.137(a) addresses revival based upon an unavoidable delay in prosecution or payment of the required issue fee, whereas 37 CFR 1.137(b) addresses revival based upon an unintentional delay in prosecution or payment of the required issue fee.

**(a) Requirements for a petition under 37 CFR 1.137(a) (delay was unavoidable):** >>obtain form

- (1) Required reply, unless previously filed.
- (2) Petition fee set forth in 37 CFR 1.17(l).
- (3) Showing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.
- (4) Any terminal disclaimer under 37 CFR 1.321 (with fee; 37 CFR 1.20(d)) dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application if the application is a design application (regardless of filing date) or a utility application filed before June 8, 1995, or a plant patent application filed before June 8, 1995. The terminal disclaimer provisions of this paragraph do not apply to lapsed patents.

**(b) Requirements for a petition under 37 CFR 1.137(b) (delay was unintentional):** >>>obtain form

- (1) Required reply, unless previously filed.
- (2) Petition fee set forth in 37 CFR 1.17(m).
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. No showing of reasons for delay is necessary. However, the Commissioner may require additional information where there is a question whether the delay was unintentional.
- (4) Any terminal disclaimer under 37 CFR 1.321 (with fee; 37 CFR 1.20(d)) dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application if the application is a design application

(regardless of filing date) or a utility application filed before June 8, 1995 or a plant patent application filed before June 8, 1995. The terminal disclaimer provisions of this paragraph do not apply to lapsed patents.

### Typical Problems Found in 37 CFR 1.137 Petitions

(1) Statements are filed by a petitioner who was **not the party responsible for prosecuting** the application at the time of the abandonment. Therefore, the petitioner is not in a position to know whether the delay was unavoidable or unintentional.

(2) The petitioner attributes fault for the delay in filing a reply to an employee such as a secretary, clerk or courier without submitting a statement from that person.

(3) Petitions are **not signed** prior to being sent by facsimile transmission or other delivery means to the Office.

(4) Petitioner **intentionally delays** the filing of a petition after first becoming aware of the abandonment. While questions are not normally raised when petitions under the unintentional standard are filed within one year of the date of abandonment, it is not appropriate to intentionally delay the filing of a petition after becoming aware of the abandoned status of the application.

(5) Petitioner does **not submit a proper reply** to an outstanding office action with the petition. By way of example, amendments filed after a final rejection, do not constitute a proper reply if the examiner refuses to have the amendment entered due to non-compliance with 37 CFR 1.116. Unless an amendment filed after a final rejection clearly places the application in condition for allowance, it is recommended that the reply filed be a Notice of Appeal, a CPA, or RCE.

(6) Petitioners mistakenly believe that **lack of knowledge of the rules or reliance on oral statements** by Office employees are acceptable reasons for a petition under the unavoidable standard to be granted.

(7) Some petitioners attempt to revive a provisional application beyond twelve months from filing. While the petition can be filed outside the twelve-month period (usually for copendency), a **provisional application** can only be pending for a period of **twelve months** from filing.

### THINGS TO REMEMBER

(1) Petitions to revive filed under either the unavoidable or the unintentional standards should be filed within **two months** of becoming aware of the abandonment of the application to avoid any question of timeliness.

(2) Renewed petitions to revive must be filed **within**

**two months of an adverse decision on the earlier petition to revive to be considered timely, unless a proper extension of time up to an additional five months (for a total of seven months) is obtained under 37 CFR 1.136(a). Otherwise, the Office may require a specific showing as to how the entire delay was unavoidable or unintentional.**

**(3) A petition under 37 CFR 1.137(a) must be accompanied by the petition fee set forth in 37 CFR 1.17(l) and a petition under 37 CFR 1.137 (b) must be accompanied by the petition fee set forth in 37 CFR 1.17(m). The petition fee is required by statute. See 35 U.S.C. 41(a)(7). Thus, the Office cannot grant requests for waiver or reduction of the requisite petition fee.**

**(4) In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application .**

**(5) In an application abandoned for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof even if the application is to then be abandoned in favor of a continuing application. In a patent lapsed for failure to pay the balance of issue fee due, the required reply is payment of the balance of issue fee due.**

**(6) In a provisional application abandoned for failure to timely comply with an Office requirement, the reply requirement must be met by a complete reply to such Office requirement.**

**(7) 37 CFR 1.137(b) is applicable to applications abandoned and patents lapsed, regardless of the length of time that the application was abandoned or the patent was lapsed. However, note that 37 CFR 1.137(b) requires that the entire period of delay, from the due date of the reply to the date of filing a grantable petition to revive, was unintentional for a petition under 37 CFR 1.137(b) to be granted.**

**(8) While a statement of unintentional delay for the entire period of abandonment is generally sufficient, 37 CFR 1.137(b) authorizes the Office to require additional information when there is a question whether the entire delay was unintentional. In such instances, the Office may require evidence for each of the three critical periods: (1) the delay in filing a timely reply before abandonment of the application or lapse of the patent; (2) the delay in filing an initial petition to revive; and (3) the delay in filing a grantable petition to revive.**

**(9) An applicant who deliberately delays the filing of a petition under 37 CFR 1.137 will not be able to show that "the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional".**

**(10) Examples of situations where unintentional delay**



was argued but the Office held these activities to constitute **intentional delay**:

(A) where the applicant **deliberately permits** an application to become abandoned (i.e., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that an invention lacks sufficient commercial value to justify continued prosecution);

(B) where the applicant **chooses not to seek or persist in seeking revival** of an abandoned application, or where the applicant **deliberately chooses to delay seeking revival** of an abandoned application;

(11) An **intentional delay** resulting from a deliberate course of action chosen by the applicant **is not affected by**: (a) the correctness of the applicant (or applicant's representative) decision to abandon the application or not to seek or persist in seeking revival of the application; (b) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (c) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

(12) An **intentional abandonment** of an application, or an **intentional delay** in seeking either the withdrawal of a holding of abandonment in, or the revival of, an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137.

(13) Where an applicant **chooses not to seek revival** of an application, or **chooses not to persist in seeking revival** after an adverse decision on an earlier petition, the resulting delay cannot be considered to be unavoidable or unintentional.

(14) A **provisional application** can be revived for a period **not to exceed 12 months** from the **date of filing**, even if the petition is filed outside this 12 month period.

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#### **D. Relating to Maintenance Fees**

Maintenance fees may be paid during the **6 month period** following the **3rd, 7th, and 11th anniversary** of issuance of a utility patent. If not timely paid, a **surcharge** will be required between **3 ½ and 4 years, 7 ½ and 8 years, and 11 ½ and 12 years** after issuance of the patent. **Utility patents** will expire after **4 years, 8 years and 12 years** from issuance if the maintenance fee and surcharge, if required, are **not timely paid**. The due date for payment of maintenance fees in reissue applications is computed from the date

of grant of the original non reissue application. See MPEP Chapter 2500.

**1. Payment Prior to Expiration** See MPEP 2580

A patentee who is not satisfied with the USPTO refusal to accept and record a maintenance fee paid prior to expiration of a patent may petition under 37 CFR 1.377. The requirements for acceptance of the payment are:

- (1) **Petition** under 37 CFR 1.377;
- (2) Filing within **2 months** of action complained of or within the time set in the action complained of;
- (3) **Petition fee**; 37 CFR 1.17(h). The petition may include a request for refund of the petition fee if the refusal to accept and record the maintenance fee is determined to be Office error;
- (4) **Statement of facts** as outlined at 37 CFR 1.181(b);
- (5) **Signature** by registered attorney or party in interest as outlined at 37 CFR 1.377(c);

**2. Payment After Expiration** See MPEP 2590

(a) Requirements when the delay was **unavoidable**.  
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Payment of maintenance fees after expiration of the patent will be accepted and the patent will be reinstated as if it had never expired, provided the following are filed:

- (1) **Petition** under 37 CFR 1.378(b) **signed by** registered attorney or party in interest as outlined at 37 CFR 1.378(d).
- (2) **Maintenance fee** set forth in 37 CFR 1.20(e)-(g).
- (3) **Surcharge** set forth in 37 CFR 1.20(i)(1).
- (4) Showing of **unavoidable delay** including an enumeration of steps taken to ensure timely payment, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

(b) Requirements when the delay was **unintentional**.  
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Payment of maintenance fees after expiration of the patent will be accepted and the patent will be reinstated as if it had never expired, provided the following are filed:

- (1) **Petition** under 37 CFR 1.378(c) filed

within 24 months after the six-month grace period **signed** by registered attorney or party in interest as outlined at 37 CFR 1.378(d).

(2) **Maintenance fee** set forth in 37 CFR 1.20 (e)-(g).

(3) **Surcharge** set forth in 37 CFR 1.20(i)(2).

(4) A statement that the delay in payment of the maintenance fee was **unintentional**.

### **3. Reconsideration**

**A first request for reconsideration will be entertained provided the following are filed within two months, or such other time as set in an adverse decision on a petition filed under 2(a) or 2(b) above:**

(1) **Petition** under 37 CFR 1.378(e).

(2) **Petition fee** set forth in 37 CFR 1.17(h).

(3) **All pertinent evidence or arguments** presented since no further request for reconsideration will be entertained.

A common error made in the filing of a maintenance fee petition is the **lack of proper identification** (by both the patent number and the application number) of the patent as required by § 1.366(c).

**KEY:** =online business system =fees =forms =help =laws/regulations =definition (glossary)

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